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EXAMINER

FERNANDEZ RIVAS, OMAR F

ART UNIT

PAPER NUMBER

2129

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,371

Applicant(s)

MAZZONE, THOMAS

Examiner

Omar F. Fernández Rivas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to application **09/932,371** filed 8/17/01 as well as the Amendment Submitted/Entered with Filing of Request for Continued Examination (RCE) filed 12/6/04. Claims 1-52 filed by the applicant have been entered and examined. An action on the merits of claims 1-52 appears below.

Priority

2. Applicant's claims for domestic priority against application numbers 60/226,401 filed **8/18/00** and 60/279,870 filed 3/29/01 under 35 U.S.C. 119(e) are acknowledged.

Claim Rejections - 35 USC §103(a)

3. Applicant's arguments have been considered but are moot in view of new grounds of rejection necessitated by new issue(s) raised in applicant's amendment. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-16, 19-32, 34-41 and 44-52 are rejected under 35 U.S.C. 103(a) as obvious over Rozen et al USPN 6,073,106 "Method of Managing and Controlling Access to Personal Information" (Issued June 6, 2000, Filed October 30, 1998; referred to as Rozen) in view of Newton et al USPN 5,771,291 "User identification and

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authentication system using ultra long identification keys and ultra large databases of identification keys for secure remote terminal access to a host computer" (June 23, 1998; referred to as Newton) and in further view of *Jacobson* USPN 6,488,205 "System and method for processing data on an information card" (Filed Dec. 3, 1999; referred to as Jacobson).

Regarding claims 1, 13, 24, 39 and 49:

Rozen teaches,

- a database of health information descriptions, each description relating to a patient and an associated pair, the associated pair comprising an associated access code, which is associated with the patient, and an associated password, which is associated with a non-patient user of the system (Abstract, lines 1-7, "Via Internet...for each category"; column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 5, lines 21-26, "As used herein,...such personal records"; column 7, lines 4-14; "Once the participant...in an emergency"; Column 10, lines 57-63, "The first prompt...emergency PIN"; there must be a database to store the data provided by the user. The constant identifier is considered to be an associated access code. E-PIN and C-PIN are provided to other users so that they can access the patient's data).

- a first computer programmed to provide a prospective pair substantially simultaneously, the prospective pair comprising a prospective access code and a prospective password, the prospective password being associated with a user of the system (column 10, line 57-63, "The first prompt...emergency PIN"; the emergency PIN is the password).

- a second computer, in communication with the database and with the first computer, the second computer being programmed to determine whether the prospective pair corresponds to one of the associated pairs, and if the prospective pair is determined to correspond to the associated pair, then the second computer provides only the description that corresponds to the prospective pair (column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 6, lines 12-48, "Once the foregoing...health information..."; Column 9, lines 48-59, "As illustrated...to be transmitted"; column 12, lines 13-18, "disclosing...by the requester"; Figs. 1A-1D; a computer must determine if the correct password has been entered for each category).

However, *Rozen* doesn't explicitly teach providing description(s) if the prospective pair is determined to correspond to one of the associated pairs on a computer readable memory on a portable card, the memory having stored therein a prospective access code, which is associated with a patient while *Newton et al* teaches, - providing description(s) if the prospective pair is determined to correspond to one of the associated pairs (Fig. 1; column 2, lines 46-56, "The initial step ... encryption key codes")

Jacobson teaches,

- a computer readable memory on a portable card (column 4, lines 32-48, "The present invention ... of information media")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for improving security (*Newton*, column 2, lines 35-46, "the new and improved ...to be readily employed") and eliminating data input errors (*Jacobson*,

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column 2, lines 11-30, "Thus, there is a ... information card management systems").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Rozen* as taught by *Newton* and *Jacobson* for the purpose of improving security as well as eliminating data input errors.

Regarding claims 2, 25, 29 and 50:

Rozen teaches the first computer is programmed to provide a change to one of the descriptions (Abstract, lines 12-14, "Alterations of any...by the requester"; column 7, lines 15-39, "To make changes...information exchange"; programming a computer is providing code modules).

Regarding claims 3, 14, 30 and 40

Rozen teaches the second computer is programmed to receive the change to the one of the descriptions, and then modify the database to reflect the change (column 7, lines 4-14, "Once the participant...in an emergency"; storing the new information modifies the database).

Regarding claims 4, 15, 26, 31, 41 and 51

Rozen teaches the second computer is programmed to record who made the change to one of the descriptions column 7, lines 15-39, "To make changes...information exchange"; archiving the changes made to the participants data file is recording who made the changes).

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Regarding claims 5 and 16:

The rejection of claims 5 and 16 is the same as that for claim 1 as recited above since the stated limitations of the claim are set forth in the references.

Regarding claims 8, 19 and 34:

Rozen teaches one of the associated pairs is issued to one of the patients, and the description corresponding to the one of the patients is related to the one of the associated pairs (column 4, lines 33-67, column 5, lines 1-9 "The present invention...to disclose it"; column 7, lines 4-14, "Once the participant...in an emergency")

Regarding claims 9, 20, 35 and 45:

The rejection of claims 9, 20, 35 and 45 is the same as that for claim 1 as recited above since the stated limitations of the claim are set forth in the references.

Regarding claims 10, 21, 36 and 46:

The rejection of claims 10, 21, 36 and 46 is the same as that for claim 1 as recited above since the stated limitations of the claim are set forth in the references.

Regarding claims 11, 22, 37 and 47:

The rejection of claims 11, 22, 37 and 47 is the same as that for claim 1 as recited above since the stated limitations of the claim are set forth in the references.

Regarding claims 12, 23, 27, 38 and 48:

Rozen teaches the second computer is programmed to cause a message to be sent to a user of the system, the user being related to an associated pair (column 12, lines 13-18, "disclosing...by the requester"; column 7, lines 37-67, "In the event...and/or password"; prompting the participant to change the E-PIN or C-PIN when

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a medical care provider accesses the information is a message to the user related to the associated pair).

Regarding claim 28:

Rozen teaches,

- a database of health information descriptions, each description relating to a patient and an associated access code, and wherein the associated access code has at least two acceptable passwords associated with it, wherein at least one of the acceptable passwords corresponds to a non-patient user of the system and is associated with the prospective access code (Abstract, lines 1-7, "Via Internet...for each category"; column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 5, lines 21-26, "As used herein,...such personal records"; column 7, lines 4-14; "Once the participant...in an emergency"; Column 10, lines 57-63, "The first prompt...emergency PIN"; there must be a database to store the data provided by the user. The constant identifier is considered to be an associated access code. E-PIN and C-PIN are provided to other users so that they can access the patient's data and are related to the constant identifier).

- a card having thereon a first computer programmed to provide a prospective access code upon entry of at least one acceptable password (column 8, lines 20-64, "The present method...communications or fax"; the prospective access code is the constant identifier. The E-PIN or authorization code is the acceptable password).

- a second computer, in communication with the data base and with the first computer, the second computer being programmed to determine whether of the

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associated the prospective access code corresponds to one access codes, and if the prospective access code is determined to correspond to one of the associated access codes, then the second computer provides only the description that corresponds to the prospective access code (column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 6, lines 12-48, "Once the foregoing...health information..."; Column 9, lines 48-59, "As illustrated...to be transmitted"; column 12, lines 13-18, "disclosing...by the requester"; Figs. 1A-1D; a computer must determine if the correct password has been entered for each category).

However, *Rozen* doesn't explicitly teach providing description(s) if the prospective access code is determined to correspond to one of the associated access codes or the card is a portable card while *Newton* teaches,

- providing description(s) if the prospective access code is determined to correspond to one of the associated access codes (Fig. 1; column 2, lines 46-56, "The initial step... encryption key codes").

Jacobson teaches,

- the card is a portable card (column 4, lines 32-48, "The present invention ... of information media")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for improving security (*Newton*, column 2, lines 35-46, "the new and improved ...to be readily employed") and eliminating data input errors (*Jacobson*, column 2, lines 11-30, "Thus, there is a ... information card management systems").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made, to modify *Rozen* as taught by *Newton* and *Jacobson* for the purpose of improving security as well as eliminating data input errors.

Regarding claim 44:

Rozen teaches issuing one of the associated access codes to one of the patients, and relating the one of the associated access codes with only the description relating to the one of the patients (column 4, lines 33-67, column 5, lines 1-9 "The present invention...to disclose it"; column 5, lines 1-9 "The present invention...to disclose it"; column 7, lines 4-14, "Once the participant...in an emergency")

Regarding claim 52:

Rozen teaches a computer readable program code module to instruct a computer to provide a message to a user related to an associated access code when the description is provided to someone other than the user (column 7, lines 37-67, "In the event...and/or password"; prompting the participant to change the E-PIN or C-PIN when a medical care provider accesses the information is a message to the user when someone else accesses the information).

4. Claims 6-7, 17-18, 32-33 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rozen* in view of *Newton* in view of *Jacobson* and in further view of *Corcoran et al* "Smart Cards and Biometrics: Your Key to PK1" (March 1999; referred to as *Corcoran*).

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Regarding claims 6 and 17:

Rozen teaches,

- a database of health information descriptions, each description relating to a patient and an associated pair, the associated pair comprising an associated access code, which is associated with the patient, and an associated password, which is associated with a non-patient user of the system (Abstract, lines 1-7, "Via Internet...for each category"; column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 5, lines 21-26, "As used herein,...such personal records"; column 7, lines 4-14; "Once the participant...in an emergency"; Column 10, lines 57-63, "The first prompt...emergency PIN"; there must be a database to store the data provided by the user. The constant identifier is considered to be an associated access code. E-PIN and C-PIN are provided to other users so that they can access the patient's data).

- a first computer programmed to provide a prospective pair substantially simultaneously, the prospective pair comprising a prospective access code and a prospective password, the prospective password being associated with a user of the system (column 10, line 57-63, "The first prompt...emergency PIN"; the emergency PIN is the password).

- a second computer, in communication with the database and with the first computer, the second computer being programmed to determine whether the prospective pair corresponds to one of the associated pairs, and if the prospective pair is determined to correspond to the associated pair, then the second computer provides only the description that corresponds to the prospective pair (column 4, lines 33-67,

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column 5, lines 1-9, "The present invention...to disclose it"; column 6, lines 12-48, "Once the foregoing...health information..."; Column 9, lines 48-59, "As illustrated...to be transmitted"; column 12, lines 13-18, "disclosing...by the requester"; Figs. 1A-1D; a computer must determine if the correct password has been entered for each category). However, *Rozen* doesn't explicitly teach providing description(s) if the prospective pair is determined to correspond to one of the associated pairs on a computer readable memory on a portable card, the memory having stored therein a prospective access code, which is associated with a patient or fingerprint passwords while *Newton* teaches, - providing description(s) if the prospective pair is determined to correspond to one of the associated pairs (Fig. 1; column 2, lines 46-56, "The initial step ... encryption key codes")

Jacobson teaches,

- a computer readable memory on a portable card (column 4, lines 32-48, "The present invention ... of information media")

Corcoran teaches,

- the prospective password is a fingerprint (page 4, sentences 2-3, "Newer biometric measurements...is the fingerprint")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for improving security (*Newton*, column 2, lines 35-46, "the new and improved ...to be readily employed"), eliminating data input errors (*Jacobson*, column 2, lines 11-30, "Thus, there is a ... information card management systems") and developing secure applications/communications (*Corcoran*, page 7, Conclusion section,

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sentence 1, "Integrating smart cards...applications and communications"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Rozen* as taught by *Newton*, *Jacobson* and *Corcoran* for the purpose of improving security as well as eliminating data input errors and developing secure applications/communications.

Regarding claims 7, 18 and 33:

The rejection of claims 7, 18 and 33 is similar to that for claims 1 and 6 as recited above since the stated limitations of the claim are set forth in the references. Claims 7, 18 and 33 limitations difference is taught in *Corcoran*:

- the prospective password is a retinal scan (page 4, sentences 2-3, "Newer biometric measurements...is the fingerprint")

Regarding claim 32:

Rozen teaches:

- a database of health information descriptions, each description relating to a patient and an associated access code, and wherein the associated access code has at least two acceptable passwords associated with it, wherein at least one of the acceptable passwords corresponds to a non-patient user of the system and is associated with the prospective access code (Abstract, lines 1-7, "Via Internet...for each category"; column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 5, lines 21-26, "As used herein,...such personal records"; column 7, lines 4-14; "Once the participant...in an emergency"; Column 10, lines 57-63, "The first prompt...emergency PIN"; there must be a database to store the data provided by the

user. The constant identifier is considered to be an associated access code. E-PIN and C-PIN are provided to other users so that they can access the patient's data and are related to the constant identifier).

- a card having thereon a first computer programmed to provide a prospective access code upon entry of at least one acceptable password (column 8, lines 20-64, "The present method...communications or fax"; the prospective access code is the constant identifier. The E-PIN or authorization code is the acceptable password).

- a second computer, in communication with the data base and with the first computer, the second computer being programmed to determine whether of the associated the prospective access code corresponds to one access codes, and if the prospective access code is determined to correspond to one of the associated access codes, then the second computer provides only the description that corresponds to the prospective access code (column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 6, lines 12-48, "Once the foregoing...health information..."; Column 9, lines 48-59, "As illustrated...to be transmitted"; column 12, lines 13-18, "disclosing...by the requester"; Figs. 1A-1D; a computer must determine if the correct password has been entered for each category).

However, *Rozen* doesn't explicitly teach providing description(s) if the prospective access code is determined to correspond to one of the associated access codes, the card is a portable card or fingerprint passwords while *Newton* teaches,

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- providing description(s) if the prospective access code is determined to correspond to one of the associated access codes (Fig. 1; column 2, lines 46-56, "The initial step... encryption key codes").

Jacobson teaches,

- the card is a portable card (column 4, lines 32-48, "The present invention ... of information media")

Corcoran teaches,

- the prospective password is a fingerprint (page 4, sentences 2-3, "Newer biometric measurements...is the fingerprint")

Motivation – The portions of the claimed system would have been a highly desirable feature in this art for improving security (*Newton*, column 2, lines 35-46, "the new and improved ...to be readily employed"), eliminating data input errors (*Jacobson*, column 2, lines 11-30, "Thus, there is a ... information card management systems") and developing secure applications/communications (*Corcoran*, page 7, Conclusion section, sentence 1, "Integrating smart cards...applications and communications"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Rozen* as taught by *Newton*, *Jacobson* and *Corcoran* for the purpose of improving security as well as eliminating data input errors and developing secure applications/communications.

Regarding claim 42:

Rozen teaches,

- a database of health information descriptions, each description relating to a patient and an associated pair, the associated pair comprising an associated access code, which is associated with the patient, and an associated password, which is associated with a non-patient user of the system (Abstract, lines 1-7, "Via Internet...for each category"; column 4, lines 33-67, column 5, lines 1-9, "The present invention...to disclose it"; column 5, lines 21-26, "As used herein,...such personal records"; column 7, lines 4-14; "Once the participant...in an emergency"; Column 10, lines 57-63, "The first prompt...emergency PIN"; there must be a database to store the data provided by the user. The constant identifier is considered to be an associated access code. E-PIN and C-PIN are provided to other users so that they can access the patient's data).

- a first computer programmed to provide a prospective pair substantially simultaneously, the prospective pair comprising a prospective access code and a prospective password, the prospective password being associated with a user of the system (column 10, line 57-63, "The first prompt...emergency PIN"; the emergency PIN is the password).

- a second computer, in communication with the database and with the first computer, the second computer being programmed to determine whether the prospective pair corresponds to one of the associated pairs, and if the prospective pair is determined to correspond to the associated pair, then the second computer provides only the description that corresponds to the prospective pair (column 4, lines 33-67, column 5,

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lines 1-9, "The present invention...to disclose it"; column 6, lines 12-48, "Once the foregoing...health information..."; Column 9, lines 48-59, "As illustrated...to be transmitted"; column 12, lines 13-18, "disclosing...by the requester"; Figs. 1A-1D; a computer must determine if the correct password has been entered for each category).

However, *Rozen* doesn't explicitly teach providing description(s) if the prospective access code is determined to correspond to one of the associated access codes, the card is portable having thereon a computer readable memory or fingerprint passwords while *Newton* teaches,

- providing description(s) if the prospective access code is determined to correspond to one of the associated access codes (Fig. 1; column 2, lines 46-56, "The initial step... encryption key codes").

Jacobson teaches,

- the card is portable having thereon a computer readable memory (column 4, lines 32-48, "The present invention ... of information media")

Corcoran teaches,

- providing a password includes providing a fingerprint having thereon a pattern corresponding to the password (page 4, sentences 2-3, "Newer biometric measurements...is the fingerprint")

Motivation – The portions of the claimed method would have been a highly desirable feature in this art for improving security (*Newton*, column 2, lines 35-46, "the new and improved ...to be readily employed"), eliminating data input errors (*Jacobson*, column 2, lines 11-30, "Thus, there is a ... information card management systems") and

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developing secure applications/communications (*Corcoran*, page 7, Conclusion section, sentence 1, "Integrating smart cards...applications and communications"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Rozen* as taught by *Newton*, *Jacobson* and *Corcoran* for the purpose of improving security as well as eliminating data input errors and developing secure applications/communications.

Regarding claim 43:

The rejection of claim 43 is similar to that for claims 39 and 42 as recited above since the stated limitations of the claim are set forth in the references. Claim 43's limitations difference is taught in *Corcoran*:

Corcoran teaches,

- providing a password includes providing a retina having thereon a pattern corresponding to the password (page 4, sentences 2-3, "Newer biometric measurements ... is the fingerprint")

RESPONSE TO APPLICANTS' AMENDMENT REMARKS

Claim Rejections - 35 USC § 103

5. Applicant's arguments have been fully considered, but are moot in view of new grounds of rejection necessitated by new issue(s) raised in applicant's amendment.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence Information

7. Any inquires concerning this communication or earlier communications from the examiner should be directed to Omar F. Fernández Rivas, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-2589 or email omar.fernandez_rivas@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

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Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Omar F. Fernández Rivas
Patent Examiner
Artificial Intelligence Art Unit 2129
United States Department of Commerce
Patent & Trademark Office

Tuesday, February 07, 2006

OFK

David Vincent 2/16/06
DAVID VINCENT
SUPERVISORY PATENT EXAMINER